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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/430,966 11/01/99 DE CORTE

B JAB-1425

EXAMINER

HM12/0608

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BALASUBRAMANIAN, V

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

06/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/430,966

Applicant(s)

DE CORTE ET AL.

Examiner

Venkataraman  
Balasubramanian

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-14 and 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

### DETAILED ACTION

Applicants' response, which included addition of new claims 18-20, filed on 3/28/2001 is made of record.

Claims 1-6, 8-14 and 16-20 are now pending.

In view of applicants' response, the following remains.

#### ***Claim Rejections - 35 USC § 112***

Claims 1-6, 8-14 and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Following reasons apply. Any claim not specifically rejected is rejected as being dependent on a rejected claim.

1. Claim 1 is also indefinite as it recites " quaternary amine". It is not clear what "quaternary amine" is being referred to and where the group is to be present.
2. Also in claim 1 in the definition of various R groups, the presence of a parenthesis in the group "di(methyl)aminocarbonyl " is unclear.
3. Reason # 1 and 2 also apply to claim 6.
4. Recitation of R4 and R5 taken together may form a "azido" , in claim 1 and 8, is indefinite as it is not clear how such a group could be formed.
5. Claim 14 is a substantially duplicate of claim 16 as they both depend on the same scope of active ingredient and have no material difference. Different intended uses in such claims are given no significant weight. Note In re Tuominen 213 USPQ 89.

Art Unit: 1624

6. The newly presented claim 20 is exact duplicate of newly added claim 19.

Applicants should note that reasons # 1 through 5 are same as made in the previous office action. Applicants argument to overcome these rejections were considered but were deemed as not persuasive. Following apply.

Contrary to applicants' urging, there is no "quaternary amine". It is only quaternary nitrogen or quaternary ammonium group. Furthermore, applicants are claiming compounds and hence the structural make-up of the compound containing the quaternary nitrogen should be disclosed for the extent of protection claimed.

As for "di(methyl)aminocarbonyl " group, as recited it is indefinite as with normal interpretation of the parenthesis , the methyl is attached to carbonyl group which cannot bear two amino groups.

As for "azido" group, recitation of R4 and R5 taken together form a "azido" is incorrect as they cannot form the said groups. Note if they were nitrogen, they form a "azo" group.

Again claim 14 is substantially duplicate claim as there is no material difference.

Hence, these rejections made in the previous office action are maintained.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutchings et al. US 6,048,86 for reasons of record. .

Contrary to applicants' urging that Hutchings et al. does not teach the instant R<sub>2a</sub>, Hutchings et al. teaches in the definition of R<sup>1</sup>, R<sup>2</sup> and R<sup>3</sup> embrace groups recited for R<sub>2a</sub> as pointed out by the examiner in the previous office action. As seen on col. 1 and col.2, the groups R<sup>1</sup>, R<sup>2</sup> and R<sup>3</sup> can be a cyano or substituted or unsubstituted aminocarbonyl hence the rejection is proper and is maintained..

Claims 1-6 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. US 6,093,716 for reasons of record.

Applicants' argument to overcome this rejection is not persuasive. First of all, contrary to applicants' urging that instant claims are limited to "pyrimidineamine substituted with a para-substituted phenyl group " only is incorrect. Besides, "para-substituted phenyl group ", instant claims includes other heterocyclic groups as seen choices b-2 through b-7. Hence Davis et al. teachings of several substituted 2-heteroaminopyrimidines is applicable to instant claims. Furthermore, optional substituents of Het groups embrace groups recited in the instant claims for R<sup>2</sup> and R<sub>2a</sub>. Hence the rejection is proper and is maintained.

Claims 1-6 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckman et al. US 5,691,364 for reasons of record.

Applicants' argument to overcome this rejection is not persuasive. Applicants argue that Buckman et al. has exemplified only two pyrimidines. But number of examples is not a criteria to access whether instant claims read on prior art and as

Art Unit: 1624

applicants would know only objective enablement is required. Applicants also argue that Buckman et al. has not taught aminophenyl compounds. As noted in the previous office action, Buckman et al. teaches both the equivalency and interchangeability of herein exemplified substituents with that claimed herein. See cols. 4, formula III, V and VIII, especially the definitions of R1, R2, R3, R4, R5, R6, R7, Z1 and Z2 groups as noted above. Hence, one having ordinary skill in the art at the time of the invention was made would have been motivated to make compounds variously substituted in pyrimidine ring and the aryl ring as permitted by the reference and expect resulting compounds (instant compounds) to possess the uses taught by the art in view of the equivalency teaching outline above.

Hence the rejection is proper and is maintained.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian ( Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Application/Control Number: 09/430,966

Page 6

Art Unit: 1624

VB

V. Balasubramanian (Bala)

6/6/2001

*Mukund J. Shah*

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SUPERVISORY PATENT EXAMINER

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